

#61 Election PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Holger RASMUSSEN

Serial Number: 09/435,718

Filed: November 8, 1999

For: WEB TRANSFER MECHANISM FOR  
FLEXIBLE SHEET DISPENSER



Group Art Unit: 3724

Examiner: C. Dexter

Attorney Docket No. 00242.81028

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the restriction requirement mailed October 2, 2000 in connection with the above-identified patent application, applicant hereby elects the invention of Group II, Claims 1 and 3-8. This election is made **with traverse**.

It is respectfully submitted that the subject matter of all of claims 1-16 is sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See M.P.E.P. § 803 in which it is stated that "[i]f the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to applicant, and duplicative examination by the Patent Office.

Moreover, it is respectfully submitted that the restriction between groups I-V is improper, as the identified groups of claims do not fall into one of the classes of claims eligible for

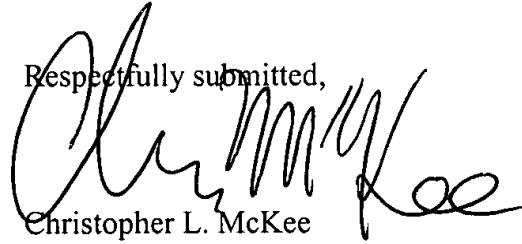
restriction as set forth in M.P.E.P. §§ 806.05-806.05(i). At best, certain of the claims are related to each other as combination and subcombination, as described in M.P.E.P. §§ 806.05(a) and 806.05(c).

Claim 1 is independent and each of claims 2-14 depend from claim 1. The Office Action states, at ¶ 2 thereof, that “claims 1-14 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g., the web cutting knife of Group I).” This amounts to a presumption that claim 1 is not patentable, which is directly contrary to M.P.E.P. § 806.05(a). That section provides (emphasis added): “[r]elative to questions of restriction where a combination is alleged, **the claim thereto must be assumed to be allowable** (novel and unobvious) as pointed in M.P.E.P. § 806.02, in the absence of a holding by the Examiner to the contrary.”

In addition, as explained in M.P.E.P. § 806.05(c), “in order to establish that combination and subcombination inventions are distinct [for purposes of restriction], two-way distinctness must be demonstrated.” Namely, it must be shown that a combination as claimed “(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), **and** (B) the subcombination can be shown to have utility either by itself or in other and different relations.” *Id.* (emphasis added). Two-way distinctness cannot be shown between claim 1 and any of the claims depending from claim 1, because each combination claim depending from claim 1 includes, by virtue of its dependency, the particulars of the subcombination recited in claim 1.

For all of the above reasons, withdrawal of the restriction requirement and examination on the merits of all of claims 1-16 are respectfully requested. At a minimum, the restriction between identified claim Groups I-V should be withdrawn and all of claims 1-14 should be examined upon the merits.

Respectfully submitted,



Christopher L. McKee  
Registration No. 32,384

BANNER & WITCOFF, LTD.  
Eleventh Floor  
1001 G Street, N.W.  
Washington, D.C. 20001-4597  
(202) 508-9100

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